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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,727	03/04/2002	Shalom Levi	1268-083A	2222

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EXAMINER

TRAN, SUSAN T

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/086,727	<b>Applicant(s)</b> LEVI ET AL.	
	<b>Examiner</b> Susan T. Tran	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-13 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-13 and 19-28 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of applicant's Amendment, Affidavit and Request for Extension of Time filed 09/22/03, Request for Continued Examination and Extension of Time filed 10/20/03.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/20/03 has been entered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "animals are" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "carboxylic acid" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-11, 19-22, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. US 4,909,986

Kobayashi teaches aqueous deodorant composition comprising water-soluble polymer having molecular weight higher than 15,000, perfumes, citric acid, and other additives (columns 1-2). The water-soluble polymer can be selected from nonionic, anionic, cationic, or amphoteric, including polyacrylic acid or polyacrylamide (columns 5-7, and examples). The aqueous deodorant composition can be applied by spraying onto liquid or solid selected from cattle raising farm, chicken farm, and livestock product, which has malodor and/or gives off malodors (columns 10-12).

The examiner notes the use of the transitional phrase "consisting essentially of" in claim 1. However, since the prior art composition has the same basic and novel characteristic (aqueous deodorant to remove malodors from animal farm), it is an applicant's burden to establish that other additives in the prior art composition are excluded from the claim by "consisting essentially of" language. See, e.g., PPG, 156 F.3d at 1355, 48 USPQ at 1355. Furthermore, even when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional

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steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

It is noted that the reference does not teach that the composition facilitating easy handling of said deodorized excrement recites in claim 21, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Kobayashi does not teach the claimed amount of the water-soluble polymer. However, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, it would have been obvious for one of ordinary skill in the art to, by routine experimentation modify the aqueous deodorant composition of Kobayashi with the expectation of at least similar result. The reason is Kobayashi

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teaches the use of the same water-soluble polymer and the same acid agents for the same purpose, e.g., to remove malodors from livestock.

Claims 11-13, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al., and Shimizu US 4,839,089.

Kobayashi is relied upon for the reasons stated above. The reference is silent as to the specific perfume, such as limonene.

Shimizu teaches deodorant composition comprising perfume selected from alpha-pinene, terpenoid, and limonene (column 6, lines 34-36). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to prepare Kobayashi's deodorant composition using limonene as perfume in view of the teaching of Shimizu, because the references teach the use of perfume to reduce malodors. The expected result would be an aqueous deodorant composition that exhibits a deodorizing effect on liquids and solids, which give off odors.

Claims 1, 5-10, 19-22, 25, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd et al. US 5,882,638.

Dodd teaches aqueous odor-absorbing composition comprising citric acid and water-soluble polymer having molecular weight higher than 15,000, e.g., polyacrylic acid (columns 6-7). Dodd does not teach the use of the composition on animal excrement, and/or composition facilitating easy handling of said deodorized excrement. However, the intended use of the claimed composition does not patentably distinguish the

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composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Accordingly, it would have been *prima facie* obvious for one of ordinary skill in the art to, by routine experimentation prepare Dodd's composition with the expectation of at least similar purpose, because Dodd teaches the use of the same water-soluble polymer and acid to obtain an aqueous deodorant composition.

### ***Response to Arguments***

Applicant's arguments filed 09/22/03 have been fully considered but they are not persuasive.

The Declaration filed on 09/22/03 under 37 CFR 1.131 or 1.132 has been considered but is ineffective to overcome the Kobayashi reference. The Declaration does not provide a side-by-side example showing that the water-soluble polymer taught by Kobayashi is not a film-forming polymer.

Applicant argues that not all water-soluble polymers are film-forming polymer. Nonetheless, applicant's generic claims have not identified any specific type of film-forming polymer. It is noted that Kobayashi also teaches the claimed water-soluble polymer. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the

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prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Applicant further alleges that the upper limit of polymer taught by Kobayashi is still lower than the claimed lower limit of 0.1%. However, it is noted that the 0.05 to 50 ppm of water-soluble film-forming polymer disclosed in column 9 is referring to solids weight. Example 54 in column 23 discloses an aqueous solution containing 10% solids of an amphoteric **polymer** of acrylamide/**acrylic acid**.

Applicant argues that the acids taught by Kobayashi are neutralized as their alkali metal or calcium salts, and therefore, does not disclose the claimed invention, "a carboxylic acid in free form". Contrary to the applicant's argument, the salts of acids taught by Kobayashi in column 8 is one of his *prefer* embodiments, many acids uses in Kobayashi are free form (columns 7-8).

Applicant argues that the examiner does not provide reason why a person of ordinary skill in the art would have been motivated to modify Kobayashi to arrive at the claimed invention. Contrary to the applicant's argument, applicant's attention is directed to the Office Action dated 11/01/02, in page 5, 2<sup>nd</sup> paragraph, lines 4-6, where the reason for modification of Kobayashi to arrive at the claimed invention is "Kobayashi teaches the advantageous result in the use of the same water-soluble polymer, the same carboxylic acid for the same purpose, e.g., to remove malodors from livestock".

Applicant argues that even if Kobayashi is properly modifiable, the reference still lack the claimed film-forming polymers in sufficient quantities and additionally claimed



carboxylic acid be in free form of independent claims 1 and 21. However, as discussed above, the amounts being argued are not recited in the generic claims.

In response to applicant's argument that Shimizu is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Kobayashi teaches a deodorant composition comprising lemon oil, and perfumes (column 1, lines 30-33); Shimizu also teaches a deodorant composition comprising perfume, such as limonene. In the instant case, Shimizu is relied upon solely for the teaching of limonene which can be incorporated in a deodorant composition.

Applicant argues that Dodd does not teach the use of the composition on animal excrement. However, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is

not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Accordingly, it would have been *prima facie* obvious for one of ordinary skill in the art to, by routine experimentation prepare Dodd's composition with the expectation of at least similar purpose, because Dodd teaches the use of the same water-soluble polymer and acid to obtain an aqueous deodorant composition.

Applicant further indicated that the examiner agreed that independent claim 1 of the instant application defines over Dodd and other art applied in the parent. The examiner is confused? It appears that there was no interview regarding to this instant application, which was held in January 23, 2002 as alleged by the applicant.

#### ***Claims Objection***

Claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600